

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Arnold, et al.	Art Unit :	2628
Patent No. :	7,602,390	Examiner :	Jeffrey J. Chow
Issue Date :	October 13, 2009	Conf. No. :	8418
Serial No. :	10/816,582		
Filed :	March 31, 2004		
Title :	EDGE DETECTION BASED STROKE ADJUSTMENT		

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 387 days to 394 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before May 31, 2005 (the date that is fourteen months after March 31, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on October 3, 2006, thereby according a PTO Delay of 490 days. Patentees do not dispute the PTO's calculation for this “A Delay” from June 1, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to October 3, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before November 6, 2007 (the date that is four months after July 6, 2007, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on November 7, 2007, thereby according a PTO Delay of 1 day. Patentees do not dispute the PTO's calculation for this “A Delay” from November 7, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to November 7, 2007. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A PTO action was due on or before June 11, 2008 (the date that is four months after February 11, 2008, the date on which a response to Office Action was filed). The PTO mailed a final Office Action on August 12, 2008, thereby according a PTO Delay of 62 days. Patentees do not dispute the PTO's calculation for this “A Delay” from June 12, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to August 12, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 553 days (i.e., the sum of 490 days, 1 day, and 62 days).

"B Delay"

The period beginning on April 1, 2007 (the day after the date that is three years after March 31, 2004, the date on which the application was filed), and ending October 13, 2009 (the date the patent was issued), is 927 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on July 6, 2007, and the patent issued on October 13, 2009, resulting in a period of 830 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 97 days (i.e., 927 days minus 830 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 97 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

June 1, 2005, to October 3, 2006;
November 7, 2007, to November 7, 2007; and
June 12, 2008, to August 12, 2008.

As detailed above, "B Delay" accumulated during the following period:

April 1, 2007, to July 6, 2007.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before January 3, 2007 (the date that is three months after October 3, 2006, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on February 5, 2007, thereby according an Applicant Delay of 33 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from January 4, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to February 5, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before June 6, 2007 (the date that is three months after March 6, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on July 6, 2007, thereby according an Applicant Delay of 30 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from June 7, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to July 6, 2007. See 37 C.F.R. § 1.704(b).

Patentees filed an Amendment on August 3, 2007, subsequent to a reply filed on July 6, 2007. No Applicant Delay was accorded; however, in good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 28 days for delay from July 7, 2007 to August 3, 2007. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Information Disclosure Statement on October 4, 2007, subsequent to a reply filed on August 3, 2007. No Applicant Delay was accorded; however, in good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 62 days for delay from August 4, 2007 to October 4, 2007. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before February 7, 2008 (the date that is three months after November 7, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on February 11, 2008, thereby according an Applicant Delay of 4 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from February 8, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to February 11, 2008. See 37 C.F.R. § 1.704(b).

Patentees filed a Supplemental Reply on May 7, 2008, subsequent to a reply filed on February 11, 2008. Patentees were accorded a delay of 86 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from February 12, 2008, to May 7, 2008. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Information Disclosure Statement on May 8, 2008, subsequent to a reply filed on May 7, 2008. Patentees were accorded a delay of 1 day for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from May 8, 2008, to May 8, 2008. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Information Disclosure Statement on March 23, 2009, subsequent to a reply filed on March 11, 2009. Patentees were accorded a delay of 12 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from March 12, 2009, to March 23, 2009. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 256 days (i.e., the sum of 33 days, 30 days, 28 days, 62 days, 4 days, 86 days, 1 day, and 12 days).

Terminal Disclaimer

This patent is subject to a terminal disclaimer. In it, Patentees waive and disclaim the terminal portion of the term of the entire patent to be granted upon the present patent subsequent to the expiration date of U.S. Patent No. 7,408,555 provided that any patent granted on the present application shall be enforceable only for and during such period that it is commonly owned with U.S. Patent No. 7,408,555.

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Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 387 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 650 days (i.e., the sum of 553 days of "A Delay" and 97 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 256 days (i.e., the sum of 33 days, 30 days, 28 days, 62 days, 4 days, 86 days, 1 day, and 12 days); and
- 3) Total PTA should be calculated as 394 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0636001.

Respectfully submitted,

Date: December 11, 2009 _____

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